

Office Action Summary

Application No.

10/750,361

Applicant(s)

MINAR, NELSON

Examiner

Donald L. Champagne

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 September 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-6,11-13,17-19,21-25,35-37,42 and 56-78 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-6,11-13,17-19,21-25,35-37,42 and 56-78 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. <u>5 Oct 2009</u> . |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____. | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10 September 2009 has been entered.

Claim Interpretation

2. The claims are limited to "**syndicated content**", "**syndicated feed**" and "**syndicated feed channel**". How these terms are interpreted depends first on whether or not they are given a "clear definition" in the specification.
3. Unless a term is given a "clear definition" in the specification (MPEP § 2111.01), the examiner is obligated to give claims their broadest reasonable interpretation, in light of the specification, and consistent with the interpretation that those skilled in the art would reach (MPEP § 2111). An inventor may define specific terms used to describe invention, but must do so "with reasonable clarity, deliberateness, and precision" (MPEP § 2111.01.III). A "clear definition" must establish the metes and bounds of the terms. A clear definition must unambiguously establish what is and what is not included. A clear definition is indicated by a section labeled definitions, or by the use of phrases such as "by xxx we mean"; "xxx is defined as"; or "xxx includes, ... but does not include ...". An example does not constitute a "clear definition" beyond the scope of the example.
4. The instant application contains no such clear definition for any of these three terms. "**syndicated content**" is disclosed in a rambling discourse over para. [0001] and [0007]-[0010] of the published application (US 20050165615A1). "**syndicated content**" is associated with the RSS and Atom "formats" (para. [0009]) and XML (para. [0007]). "**syndicated feed**" is associated by example with "RSS feed" (para. [0012] and [0025] with Fig. 8). "**syndicated feed channel**" is indefinite: It is explicitly disclosed (e.g., as "channel of the feed" in the abstract), but elsewhere "feed" and "channel" are used as alternate names for the same thing (e.g., para. [0008]).

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5. One of ordinary skill is a competent programmer in the advertising art. Even when limited to the advertising art, “syndication” is an old and widely-applicable concept (Google definitions of “syndication” and the Wikipedia article on “syndication”). The specification suggests the applicant is trying to claim a narrower meaning for a process that commonly uses RSS or Atom formats. From the specification (esp. para. [0007]), one of ordinary skill in the art would understand this implicit genus to be XML-based content distribution because both RSS and Atom are XML-based, and the broadest reasonable interpretation of “syndication” is “distribution”. “**syndicated content**” is then interpreted as content subjected to XML-based syndication/distribution. “**syndicated feed**” or “**syndicated feed channel**” are interpreted as the content item delivered through XML-based syndication/distribution. (See the *Atom (Standard)* Wikipedia article, first three para.)

Drawings

6. The drawings are objected to under 37 CFR 1.83(a) because they fail to show “the channel 803” as described in the specification (para. [0054] in the published application, US 20050165615A1). Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1, 2, 4-6, 11-13, 17-19, 21-25, 35-37, 42, and 56-78 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. The following terms are indefinite:

At numerous places beginning with claim 1, "feed channel" is indefinite (see para. 4 above). Applicant may overcome this rejection by using either "feed" (the preferred term in the prior art) or "channel".

In at least claims 4-6, 68 and 74, describing XML/RSS/Atom as "feeds" or "feed channels" is indefinite because XML/RSS/Atom are widely known as "formats", not as "feeds" or "feed channels", and the specification does not clearly redefine the term. Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999).

10. In claims 62 and 77, "syndicated content provider (system)" is indefinite. Although this language is used at many places in the published application (e.g., para. [0038]), it is not disclosed whether it is a business entity or a machine or apparatus. Businesses are distinguished by their ownership, are inherently indefinite and cannot impart patentability. Applicant argues (pp. 18-19), "The specification, on page 16, lines 15-22, states that the syndicated content provider system 110 can be a system, such as the system 700."¹ However, "can be" is not a defining limitation.

¹ The quoted statement could not be found in the spec., but an equivalent statement is disclosed at the beginning of para. [0068] of the published application.

Claim Rejections - 35 USC § 102 and 35 USC § 103

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 1, 2, 4, 11-13, 17-19, 23-25, 35-37, 42, 56-67, 69-73 and 75-78 are rejected under 35 U.S.C. 102(b) as being anticipated by Sheth et al. (US006311194B1, hereafter "Sheth").

14. Sheth teaches (independent claims 1, 65, 72 and 77) a method and system of generating information including targeted ads (col. 16 lines 37-55), the method (as represented by claim 65) comprising:

receiving, by at least one processor, a user request, the user request including at least one keyword (*a domain of interest*, col. 13 lines 54-56);

receiving, by at least one processor and in response to the at least one keyword, first information (*an XML string*, col. 16 lines 37-40 and col. 14 lines 23-25);

generating, by at least one processor and based on the first information, a first syndicated content information item (*individual media assets*, col. 16 lines 37-40) for a syndicated feed channel (inherently, para. 5 above);

receiving, by at least one processor and in response to the at least one keyword, a first targeted ad (a semantically targeted advertisement, col. 16 lines 40-44) for the syndicated feed channel (inherently, para. 5 above);

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generating, by at least one processor and based on the first targeted ad, a first targeted ad item (*the advertisement* tailored to the content provider's own space, col. 16 lines 52-55) for the syndicated feed channel (inherently, para. 5 above);

(inherently) storing, on a computer storage device, the first syndicated content information item and the first targeted ad item;

inserting, by at least one processor, the first targeted ad item adjacent to the first syndicated content information item to generate a syndicated feed channel (col. 16 lines 52-55); and

providing the syndicated feed channel including the first syndicated content information item and the first targeted ad item (col. 16 lines 52-55).

15. The following claim language is non-functional descriptive material (printed matter) and was not given patentable weight (MPEP § 2106.01 and 706.03(a)A):

“the first syndicated content information item being generated to include a first title, a first link², and a first description”;

“the first targeted ad item being generated to include a targeted ad title, a targeted ad link, and a targeted ad description”; and

“the syndicated feed channel including a channel title, a channel link, and a channel description”.

Printed matter is not functional because it does not alter how the process steps are to be performed to achieve the utility of the invention.

16. Sheth also teaches at the citations given above claims 2 (inherently), 4, 11-13, 17, 19, 23-25, 42, 56, 62-64 (where “ad mixer” is whatever mechanism is used to combine the delivered content and ad, col. 16 lines 52-55), 66, 67 and 78.

17. Sheth also teaches claims 35-37 (col. 9 lines 46-50);

² “Link” is given no clear definition in the specification. “Link” is associated by example with “URL”, but that does not constitute the necessary clear definition for link (para. 3 above). The examiner must give the term “link” its broadest reasonable definition, which the examiner judges to be any association, including a non-functional textual reference.

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18. The following claims add only non-functional descriptive material (printed matter) and were not given patentable weight (para. 15 above): 18, 57-60 (the arrangement of text is a non-functional artistic or formatting detail), 61, 69-71, 73, 75 and 76.
19. Claims 5,6, 68 and 74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sheth et al. (US006311194B1, hereafter "Sheth") in view of *Atom (Standard)* (Wikipedia article). Sheth does not teach that the syndicated feed format is RSS and Atom. Atom (Standard) teaches that the syndicated feed format is RSS and Atom. Because RSS and Atom are standardized, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of *Atom (Standard)* to those of Sheth.
20. In addition, under *KSR v. Teleflex* (82 USPQ 2nd 1385), the combination would be obvious because it is a simple substitution of one known element for another to obtain predictable results. *Atom (Standard)* teaches standardized formats that can be readily substituted for the custom XML formatting taught by Sheth (Fig. 6).
21. Claims 21 and 22 are rejected under 35 U.S.C. 103(a) as being anticipated by Sheth et al. (US006311194B1, hereafter "Sheth") in view of official notice. Sheth does not teach targeting ads by geography. This was a common means of targeting ads at the time of the instant invention. For example, ads for any certain merchant are only distributed in the regions where the merchant does business. Official notice of this common knowledge or fact well known in the art was taken in the Office action mailed 29 September 2008 (para. 13). Since applicant failed to traverse the examiner's assertion (para. 20 of the Office action mailed 12 March 2009), it is taken to be admitted prior art (MPEP 2144.03.C).

Response to Arguments

22. Applicant's arguments filed with an amendment on 10 September 2009 have been fully considered in the revised rejection. Many of applicant's arguments are moot because they are based on previous interpretations of claim language. The examiner has revised the interpretations herein, based on the interview of 5 October 2009 and the examiner's subsequent research.
23. Applicant argues (pp. 21-23) that the examiner has inappropriately made an "omnibus rejection" of numerous claims in groups. The applicant argues further, "this fails to provide

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the applicant with any guidance or a fair opportunity to reply.” The examiner does not agree. Grouping of claims is permitted when “the rejection is equally applicable to all claims in the group” (MPEP § 707.07(d), last para.), which the examiner believes to be true for every group used in this and previous Office actions. The essential requirement is that the rejection of each claim must be “fully and clearly stated” (*op. cit.*, beginning of first para.). The examiner believes that has been done. Merely repeating the same rejection statement “n” times for “n” claims in a group would not add anything but bulk to the rejection, and would indeed vitiate the rejection by diluting important points with the trivial.

24. Applicant argues further that the grouped rejections ignore “the difference in scope and recited features” of individual claims in the group. The examiner has not ignored these differences, but by grouping claims the examiner implies that the language does not patentably distinguish each claim from others in the group. If any two claims are patentably distinct, they could be subject to a restriction requirement as patentably distinct inventions.
25. If the applicant believes that any certain claim has not been given adequate consideration because its language patentably distinguishes it from any other claim, it should be brought specifically to the examiner’s attention. The examiner will provide an appropriate response, which could include explaining why the examiner disagrees, ordering a restriction requirement because the claims constitute patentably distinct inventions, and agreeing that the distinction does constitute possible allowable matter.

Conclusion

26. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached on Monday to Wednesday and Friday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717.
27. The examiner’s supervisor, Robert Weinhardt, can be reached on 571-272-6633. The fax phone number for all *formal* fax communications is 571-273-8300.

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28. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

20 November 2009

/Donald L. Champagne/
Primary Examiner, Art Unit 3688